

Remarks:

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,594,485, issued to Ezaki et al. (“Ezaki”). Claims 1, 3, 9, 17 and 20 are amended. No new matter has been added. Support for the amended language is provided in the specification and the drawings.

The Examiner contends that it would have been obvious to one of ordinary skill in the art, at the time of filing of Ezaki, to generate and transmit a ring back tone in the manner claimed herein. This rejection is respectfully traversed.

Ezaki is directed to a communication system for reconnecting a first mobile terminal to a second mobile terminal in a cellular communication network, when a line between one of the mobile terminals and a base station to which the mobile terminal is connected is abruptly interrupted and the line does not return to a normal state. According to Ezaki, both the first and the second mobile terminals communicate over the same communication network (i.e., a cellular communication network). Furthermore, col. 11, Ins. 60-67, to which the Examiner refers particularly suggests that the ring back tone is generated by a “base station.”

In contrast, the invention, as claimed in claim 1, is directed to solving a problem of different nature. That is, the claimed invention provides a solution to generating ring back tone in a scenario where two terminals communicate over two different communication protocols. More specifically, claim 1 recites a scenario where a mobile terminal receiving a call communicates over VOIP, such that upon receiving the call, the mobile terminal independently generates a ring back tone (i.e., “without any help from a PSTN switchboard or access gateway.”) See paragraph [0052] of the specification.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Respectfully, Ezaki fails to teach, suggest or disclose a “method of generating a ring back tone, the method comprising: identifying type of a network over which a first voice over internet protocol (VOIP) terminal communicates with a second terminal requesting a call setup; generating ring back tone data to be transmitted from the first terminal to the second terminal according to the type of the network identified; inserting the ring back tone data into a response message sent from the first terminal to the second terminal in response to the call setup; and transmitting the inserted response message from the first terminal to the second terminal” as recited in amended claim 1.

Furthermore, Ezaki expressly teaches away from the method recited in claim 1 by suggesting that the ring back tone is generated by and transmitted from a *first radio base*. In contrast, claim 1 as amended recites that the ring back tone is generated by the *first terminal* (i.e., a terminal communicating over an internet protocol, which is receiving a call). Since Ezaki directly teaches away from the claimed invention, a person of ordinary skill would not have been motivated to modify Ezaki in the direction of the claimed invention.

While the suggestion to modify this reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so,

absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference

¹ ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

For the above reasons, Ezaki does not teach or suggest the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2-8 depend from claim 1 and should be in condition for allowance by the virtue of their dependence on an allowable base claim. Amended claims 9, 17 and 20 substantially incorporate the elements of claim 1; therefore, claims 9, 17 and 20 and claims 10-16 depending from claim 9 and claims 18-19 depending from claim 17 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789 2100 to discuss the steps necessary for placing

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

the application in condition for allowance.

Respectfully submitted,

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